

REMARKS/ARGUMENTS

The Office Action of June 7, 2005, has been carefully reviewed and this response addresses the concerns stated in the Office Action. All objections and rejections are respectfully traversed.

I. STATUS OF THE CLAIMS

Claims 1-18, 21-22, and 24-43 are pending in the application.

Claims 21, 22, and 24-28 have been allowed.

Claims 6 and 16-18 have been objected to as being dependent on rejected base claims.

Claims 19, 20, and 23 have been cancelled without prejudice.

Claims 1, 2, 7, and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Treyz et al., U.S. Patent No. 6,587,835, issued July 1, 2003 (Treyz).

Claims 3-5, 8, and 10-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz in view of Aufricht et al., U.S. Patent Application No. 2002/0052781, published on May 2, 2002 (Aufricht).

Claims 1, 5, and 9 have been amended to place them in condition for allowance, or in the alternative, in form for appeal. Claim 41 has been amended to correct a typographical error.

II. RESPONSE TO ARGUMENTS

On page 2, in the Response to Arguments, the Office Action states that the handheld device of Treyz does receive the intended signal and the signal is presented to the user of the device as an advertisement or presented in a form of information on the display that exhibits certain unique qualities. The Office Action further states that the signal as presented to the handheld device display is sent and has cues or falls within a certain protocol in order to present the message in this certain manner.

Applicants respectfully point out that the intended signal can be arriving in a form of information on the display from any point, including from the handheld device itself. Applicants specifically claim that the formatting and locational context are determined in the transmitter, and that the transmitter includes a means for formatting the information into a displayable or tagged form. Thus, the intended signal is in a particular format by the time it leaves the transmitter and as a result of the action of the transmitter, a capability that is not disclosed or suggested by Treyz.

III. CLAIM REJECTIONS - 35 USC § 102(e)

On pages 2-3, in paragraphs 1-2, claims 1, 2, 7, and 9 are rejected under 35 U.S.C. § 102(e) as being anticipated by Treyz. Applicants have amended claims 1 and 9 to place them in condition for allowance, or in the alternative, in a form for appeal. Support for the amendments can be found in paragraphs 65 and 69 of Applicants' specification.

Applicants respectfully point out that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628 (CAFC, 1987), M.P.E.P. § 2131. Treyz does not disclose or suggest Applicants' claimed transmitter having a means for defining a context in the transmitter and a means for formatting information in the transmitter into a displayable or tagged form (amended claims 1 and 9).

Applicants further respectfully point out that the cited reference, Treyz, was issued on July 1, 2003, almost two years after the filing date of the present application, August 15, 2001. Treyz was filed on February 9, 2000, whereas Applicants' provisional patent application upon which the present application depends was filed on August 15, 2000. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind Treyz.

Applicants respectfully request reconsideration of the rejection in light of Applicants' amendments and the following arguments. To further Applicants' position of the patentability of amended claim 1 (and amended claims 2-8 that depend from amended claim 1), Applicants note the following.

With respect to claim 1, the Office Action states that Treyz includes a transmitter/receiver for receiving an advertisement containing information from a service provider and for conveying said advertisement to a handheld device, said transmitter comprising the following:

(1) the Office Action states that Treyz includes a transmitter comprising a means for defining a context for said transmitter (col. 23, lines 26-35: context meaning location).

In and around the cited passage, Treyz states that the location of the handheld computing device may be determined using the GPS system where the handheld computing device receives satellite signals from the GPS satellite. Treyz thus states that the handheld computing device determines its location and therefore its context. Applicants, on the contrary, claim a means for defining a context for a transmitter. Because Treyz does not disclose or suggest Applicants' claimed means for defining a context for the transmitter, Applicants assert that Treyz does not anticipate Applicants' claimed invention.

(2) the Office Action states that Treyz includes a transmitter comprising a means for formatting said advertisement into a machine-readable form to produce a transmitted signal compatible with said handheld device and relevant to said context (col. 55, lines 30-40 – device displays advertisement, thus, formatting is inherently performed).

In the cited passage, Treyz states that promotional material may be displayed by the handheld device on the handheld device. Treyz provides examples of displayed material, but Treyz does not disclose or suggest Applicants' claimed formatting the information by the transmitter into a displayable or tagged form. Treyz could have provided steps for performing formatting, such as with a mark-up language, to make it easier for the handheld device to display the incoming advertisement quickly, but Treyz did not do this. Therefore, in the absence of any disclosure or suggestion, steps or elements, that indicate that formatting of the advertisement is done in the transmitter, Applicants assert that Treyz does not anticipate Applicants' claimed invention.

Since Treyz does not anticipate each and every element of Applicants' amended claim 1, either expressly or inherently, Applicants' amended claim 1 (as well as claims 2-8 that depend, either directly or indirectly, therefrom and that further define the invention) is not anticipated by Treyz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended claim 1 (as well as claims 2-8 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended claim 1, and claims 2-8 which depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Treyz to meet Applicants' patentable limitations.

On pages 3-4, with respect to dependent claim 2, which depends from independent claim 1, the Office Action states that Treyz meets the limitation – The transmitter of claim 1 wherein said conveying means transmits a diffuse infrared signal (col. 13, lines 10-15 and col. 30, lines 3-21).

In the cited passages, Treyz states that wireless communications paths may use infrared communications. Treyz also provides examples in many places (e.g. col. 18, lines 59-65) of uses for the IR communications which are regularly referred to as “local” communications and provide for transactions such as wireless payments associated with kiosks. This type of IR is commonly referred to as direct IR, which is point-to-point, and typically a one-to-one communication which requires line of sight. Direct IR is normally built into PDAs and remote controls. Applicants claim a conveying means which transmits a diffuse IR signal. Diffuse IR allows many-to-many connections, does not require direct line of sight and can be uni-directional or bi-directional. In fact diffuse IR is very different from direct IR. Applicants assert that Treyz teaches away from the use of diffuse IR because the examples of IR usage given by Treyz indicate the use of direct IR, not diffuse IR. For example, Treyz states that an item may be added to the list by bar code scanning, by using RFID identification, by entry of product information into handheld computing device 12 using on-screen options, by receiving product information over an IR link (e.g., from a kiosk or terminal associated with the store or adjacent to the

product) (col. 29, lines 3-8). Treyz does not disclose or suggest the use of diffuse IR, and thus Treyz does not anticipate Applicants' claimed invention.

Since Treyz does not anticipate each and every element of Applicants' dependent claim 2, either expressly or inherently, Applicants' dependent claim 2 (as well as dependent claims 3-4 that depend therefrom and that further define the invention) are not anticipated by Treyz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that dependent claim 2 (as well as dependent claims 3-4 that depend therefrom) are now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to dependent claim 2, and claims 3-4 which depend therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Treyz to meet Applicants' patentable limitations.

On page 4, with respect to independent claim 9, the Office Action states that Treyz includes a handheld device operating in a context associated with a transmitter / receiver conveying a transmitted signal where the handheld device comprises means for receiving said transmitted signal to form a received signal, said transmitted signal being formatted by the transmitter, said received signal containing an advertisement including information from a service provider offering a service (col. 39, lines 6-62).

Applicants have amended claim 9 to further define the invention. Support for the amendments can be found in paragraphs 65 and 69 of Applicants' specification. Applicants respectfully request that the amendment be entered in order to place claim 9 in condition for allowance, or, in the alternative, in form for appeal.

In the cited passage, Treyz states that the handheld device may display many types of information on different exemplary regions on the handheld device display. Treyz also states that an indicator indicating the availability of a message can be displayed with the handheld computing device detects the presence of local wireless transmissions from the local wireless transmitter. Treyz does not disclose or suggest any formatting performed by the transmitter, in

particular Applicants' claimed transmitted signal being formatted into displayable and tagged for by the transmitter.

Since Treyz does not anticipate each and every element of Applicants' amended independent claim 9, either expressly or inherently, Applicants' independent claim 9 (as well as dependent claims 10-18 that depend, either directly or indirectly, therefrom and that further define the invention) is not anticipated by Treyz, and a rejection under 35 U.S.C. § 102(e) is inappropriate. Applicants assert that amended independent claim 9 (as well as dependent claims 10-18 that depend, either directly or indirectly, therefrom) is now in condition for allowance. Applicants respectfully request the withdrawal of rejections under 35 U.S.C. § 102(e) with regards to amended independent claim 9, and dependent claims 10-18 which depend, either directly or indirectly, therefrom, for the reasons set forth above. Furthermore, a 35 U.S.C. § 103 rejection of these claims would be inappropriate as well. Applicants' claimed invention is not an obvious extension of the use of Treyz to meet Applicants' patentable limitations.

Applicants assert that claim 7 is patentable based at least on its dependence on amended claim 1.

IV. CLAIM REJECTIONS - 35 USC § 103

On pages 5-7, paragraphs 3-4, claims 3-5, 8, and 10-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Treyz in view of Aufricht.

Applicants respectfully point out that Aufricht was published on May 2, 2002, almost one year after the filing date of the present application, August 15, 2001. Applicants respectfully reserve the right to file a petition under 37 C.F.R. § 1.131 to swear behind Aufricht.

On pages 5-6, with respect to amended dependent claim 5 (dependent upon claim 1),

(1) The Office Action states that Treyz discloses a system in which a handheld computing device may be used to provide a user with shopping assistance services as stated above for claim 1.

The shortcomings of Treyz have been discussed previously and will not be repeated here.

(2) The Office Action states that Treyz is silent regarding information transmitted in the form of an XML element.

(3) The Office Action states that Aufricht discloses an interactive advertisement mechanism enabled to be loaded on a mobile device and for users of mobile devices to operate with such interactive advertisements on their mobile devices in an interactive manner while in an off-line mode.

Applicants respectfully point out that Applicants claim a transmitter communicating with a handheld device. Thus the handheld device is not in an off-line mode.

(4) The Office Action states that Aufricht allows for placing objects such as interactive advertisements such as Internet of Web content on mobile devices (paragraph 33), and that Aufricht meets the following limitation: The transmitter of claim 2 wherein said information in the form of an XML element (paragraph 33 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms]).

In the cited passages, Aufricht states that an interactive advertisement mechanism can be loaded on a mobile device. The combination of Treyz and Aufricht, therefore, lack Applicants' claimed transmitter that can format information into a displayable or tagged form such as an XML element.

(5) The Office Action states that Treyz and Aufricht are combinable because they share a common endeavor, namely handheld devices and commerce system that provide advertisements to the user. The Office Action states that it would have been obvious to modify Treyz to include XML elements in communicating from the server transmitter to the user's handheld in order to provide a more refined presentation at the user's handheld.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference itself or in the knowledge

generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Applicants' disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). Further, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Applicants assert that there is neither suggestion nor motivation in either Treyz or Aufricht to format information into a displayable and tagged form in the transmitter. Since there is no teaching, suggestion, or motivation to format information by the transmitter into displayable or tagged form such as an XML element found either explicitly or implicitly in Treyz and Aufricht themselves or in the knowledge generally available to one of ordinary skill in the art, Treyz and Aufricht, separately or in combination, do not make obvious Applicants' amended dependent claim 5, which depends upon amended claim 1, either expressly or inherently. Therefore, a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that amended dependent claim 5 is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to amended dependent claim 5 for the reasons set forth above.

On page 6, with respect to dependent claims 8 and 10, the Office Action takes Official Notice that it is well known to utilize plug-ins associated with interest and that it would have been obvious to modify the Treyz/Aufricht combination to include plug-ins to connect a desired user with the desired interest and filter out those that do not share the interest.

Applicants respectfully continue to rebut the Official Notice taken that Applicants' utilization of plug-ins associated with interest would have been obvious to one having ordinary skill in the art at the time the invention was made. If it is well known to utilize plug-ins associated with interests, it should be no problem to provide a reference.

In order for a rejection under 35 U.S.C. §103 to be sustained, the Office Action must establish a prima facie case of obviousness. As pointed out in MPEP § 2142, one of the three criteria to establish a prima facie case of obviousness is that the prior art reference(s) must teach or suggest all the claim limitations. As discussed above by Applicants in the Remarks/ Arguments of the 35 U.S.C §102(e) rejections, Treyz does not anticipate all the claimed limitations of independent claims 1 and 9, and therefore dependent claims 8 and 10. Therefore, Treyz and Aufricht combined with Official Notice are not sufficient to sustain a rejection under 35 U.S.C. §103 for dependent claims 8 and 10.

Since Treyz, Aufricht, and Official Notice, separately or in combination, do not teach or suggest each and every element of Applicants' dependent claims 8 and 10, which depend upon amended independent claims 1 and 9, either expressly or inherently, Applicants' dependent claims 8 and 10 are not made obvious by Treyz, Aufricht, and Official Notice, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claims 8 and 10 are now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claims 8 and 10 for the reasons set forth above.

On pages 6-7, with respect to dependent claim 11 (dependent from independent claim 9), the Office Action states that Treyz meets the limitation – The handheld device of claim 9 wherein said transmitted signal is a diffuse infrared signal (col. 13, lines 10-15 and col. 30, lines 3-21).

In the cited passages, Treyz states that wireless communications paths may use infrared communications. Treyz also provides examples in many places (e.g. col. 18, lines 59-65) of uses for the IR communications which are regularly referred to as “local” communications and provide for transactions such as wireless payments associated with kiosks. This type of IR is commonly referred to as direct IR, which is point-to-point, and typically a one-to-one communication which requires line of sight. Direct IR is normally built into PDAs and remote controls. Applicants claim a conveying means which transmits a diffuse IR signal. Diffuse IR allows many-to-many connections, does not require direct line of sight and can be uni-directional

or bi-directional. In fact diffuse IR is very different from direct IR. Applicants assert that Treyz teaches away from the use of diffuse IR because the examples of IR usage given by Treyz indicate the use of direct IR, not diffuse IR. For example, Treyz states that an item may be added to the list by bar code scanning, by using RFID identification, by entry of product information into handheld computing device 12 using on-screen options, by receiving product information over an IR link (e.g., from a kiosk or terminal associated with the store or adjacent to the product) (col. 29, lines 3-8). Treyz does not disclose or suggest the use of diffuse IR, and thus Treyz does not anticipate Applicants' claimed invention.

On page 7, with respect to claim 15, the Office Action states that Aufricht meets the limitation – The handheld device of claim 9 wherein said advertisement is comprised of a first XML element (paragraph 33 and Table 1 [placing interactive advertisements from the internet or Web content to mobile devices with XML being one of the allowable forms]).

Aufricht states that an interactive advertisement mechanism can be loaded on a mobile device. Neither the mobile device of Aufricht nor the handheld device of Treyz is operating in a context that is associated with a transmitter, where the transmitter formats the advertisement. Applicants, on the contrary, claim (claims 9 and 15) a handheld device operating in a context associated with a transmitter, where the transmitter formats the transmitted signal, and where the transmitter transmits information that includes a first XML element. Since neither Treyz nor Aufricht nor their combination teaches or suggests each and every element of Applicants' dependent claim 15 (and dependent claims 16-18 that depend, directly or indirectly therefrom), which depends upon amended independent claim 9, Applicants' dependent claim 15 is not made obvious by Treyz/Aufricht, and a rejection under 35 U.S.C. § 103(a) is inappropriate. Applicants assert that dependent claim 15 is now in condition for allowance. Applicants respectfully request the withdrawal of the rejection under 35 U.S.C. § 103(a) with regards to dependent claim 15 for the reasons set forth above.

Applicants assert that dependent claims 3, 4, and 12-14 in combination with their respective independent base claims and intervening dependent claims are patentably distinction

from the prior art references cited in the Office action, and are further allowable based on their dependence upon allowable independent claims 1 and 9.

V. ALLOWABLE SUBJECT MATTER

On page 7, the Office Action states that claims 21, 22, and 24-43 are allowed.

On page 7, the Office Action states that claims 6 and 16-18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

VI. CONCLUSION

Independent claims 25, 29, 34, 37, and 41 and their dependent claims have been allowed. Claims 6 and 16-18 have been objected to. Amended independent claims 1 and 9 are believed to be in condition for allowance. All claims dependent upon independent claims 1 and 9 are therefore also believed to be in condition for allowance.

Although it is believed that no new fees are due as a result of the claim amendments, the Commissioner for Patents is authorized to charge additional fees or credit overpayment to Deposit Account No. 03-2410, Order No. 12078-141.

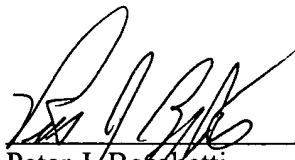
The following information is presented in the event that a call may be deemed desirable by the Examiner:

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Respectfully submitted,
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